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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Atlas Media Corp.

Serial No. 76/125,151

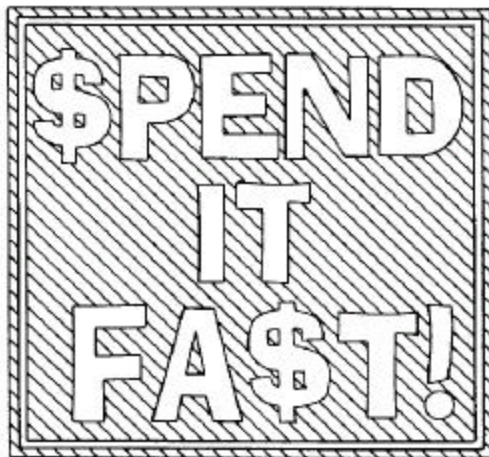
Myron Amer of Myron Amer P.C. for Atlas Media Corp.

Michael H. Kazazian, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Cissel, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Atlas Media Corp. has filed an application to register
the mark \$PEND IT FA\$T in the form shown below:



for the service of "producing TV shows, motion pictures, and home videos dealing with people, places and events around the world and selected topics of interest, and in supplying products relating to the services," in International Class 41.¹ Although this is an application based upon use in commerce, no specimen accompanied the original application papers.

In the first Office action dated March 5, 2001, the Trademark Examining Attorney noted correctly that the words comprising the last clause of the recitation of services ("...supplying products relating to the services") appear "to identify services that are merely *ancillary* to the applicant's production services and [this alleged activity] does not appear to be an actual service provided for others." In keeping with Office practice, the Trademark Examining Attorney also suggested that applicant's recitation should begin with the *prefatory* term "entertainment services, namely production of television, motion pictures, and home videos" He also explained that the application papers contained no specimen of use.

¹ Application Serial No. 76/125,151 was filed on September 11, 2000, based upon applicant's allegation of use in commerce since at least as early as June 15, 2000. The special form drawing is lined for the color green.

As evidenced by applicant's reply of June 25, 2001, counsel apparently misconstrued the nature of the refusal on the recitation of services, arguing that the absence in the original recitation of the Trademark Examining Attorney's suggested *prefatory* wording (e.g., "entertainment services, namely ...") could not render the services as *ancillary*.

Furthermore, counsel was evidently of the impression that a specimen had been filed with the original application, and he explained applicant's position as follows: "An actual specimen as it appears on the broadcast material would be too costly to reproduce and the film reel or video cassette too 'bulky' to supply"

In the Office action of September 20, 2001, the Trademark Examining Attorney made final both requirements, clarifying the problem with the recitation and noting again the absence of any specimen of record.

In applicant's response of October 15, 2001, applicant adopted the language of the recitation as proposed by the Trademark Examining Attorney and submitted a specimen supported by a declaration. The specimen is a square, adhesive-backed decal having white letters and frame against a green background, and was characterized in the declaration as a "display":



In his Office action of January 11, 2002, the Trademark Examining Attorney accepted the amended recitation of services, but found the specimens unacceptable as evidence of actual service mark use, and noted again that an acceptable service mark specimen supported by a proper declaration should be submitted to the United States Patent and Trademark Office.

Then, in a confusing step backward, applicant's counsel suggested - in the interests of accuracy and in order to clear up an earlier "misunderstanding" - that perhaps the words "*production of*" should be deleted from the most recently submitted recitation of services. Counsel argued that the specimens discussed above should then be found to be acceptable in conjunction with this latest proposed change to the recitation of services.

In the Office action of May 9, 2002, the Trademark Examining Attorney made both of the outstanding requirements final a second time - rejecting applicant's suggested amendment to the recitation of services (i.e., deleting the words "production of") as being beyond the scope of the earlier recitation, and continuing to find the labels or decals submitted by applicant inappropriate to demonstrate service mark usage for the recited services.

Despite several more exchanges, including telephone conferences, applicant failed to satisfy either requirement. The Trademark Examining Attorney insisted upon applicant's compliance with both requirements. The Office treats the failure to comply with a formal requirement as the equivalent of a refusal to register until such time as the requirement is met. It was at that juncture (June 6, 2002) that applicant filed a timely appeal to the Board. The appeal has been briefed by applicant and by the Trademark Examining Attorney, but applicant did not request an oral hearing.

Inasmuch as the Trademark Examining Attorney has not abused his discretion in making these requirements, and applicant has failed to meet these formal requirements, we affirm as to both grounds of refusal to register.

Proposed amendment beyond the scope
of the earlier recited services

We agree with the position of the Trademark Examining Attorney in refusing to accept applicant's latest attempt to change the recitation of services. With this proposed deletion of two words, applicant would be discarding an unambiguous service recitation of producing entertainment programs - for example, the actual making of a motion picture.

The Trademark Examining Attorney has noted correctly that this new phraseology appears indefinite. Certainly this is the case as applied to motion pictures and home videotapes.² In addition to introducing uncertainty about the actual nature of applicant's business, this proposed amendment contemplates a different genre of services, or perhaps even turns the focus to the marketing of hard goods. Deleting the words "production of" in connection with motion

² Provided the entertainment services specified later in the recitation were limited to "television programs," the elimination of the words "production of" would likely not be deemed significant. Generally the provision/distribution of on-going television programs is closely tied into the production thereof. Hence, the United States Patent and Trademark Office's Trademark Acceptable Identification Goods & Services Manual has entries for entertainment services in the nature of television programs that do not specifically require the clarifying wording "production of." We note for illustrative purposes only (ref. footnote 10, *supra*) that this result is reflected in applicant's earlier recitations in trademark registrations for the service marks EXOTIC ISLANDS, ROMANTIC INNS, OUT OF THIS WORLD, TENNIS WORLD, MANEATERS OF THE WILD and GOLFING AMERICA.

pictures, for example, would appear to replace the earlier service of *making* a motion picture with the "*distribution* of motion pictures" - another International Class 41 service. On the other hand, it may even be used by applicant as a trademark for hard goods, namely "motion picture films about Dotcom enterprises," in International Class 9.

Either of these interpretations would necessarily change the nature of the consumers, channels of trade, and other du Pont factors in some future likelihood of confusion case involving this property.³ This result could be perilous for a hypothetical third party who sometime after September 2000 adopted a similar mark for somewhat related services. In any event, permitting applicant to change the recitation of services from producing motion pictures to the distribution of motion pictures would be a broadening, if not an outright replacement, of the earlier recitation of services, and hence would be a violation of 37 C.F.R. §2.71(a).⁴

³ In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973) sets forth the factors that should be considered in determining likelihood of confusion.

⁴ 37 C.F.R. §2.71(a) provides that:
"The applicant may amend the application during the course of examination, when required by the Office or for other reasons.

(a) The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services."

Achieving greater certainty in the acquisition of trademark rights was a driving force behind the constructive use provisions of the Trademark Law Revision Act of 1988 (TLRA). This significant new feature of §7(c) of the Lanham Act, as amended, was premised on providing clear notice to third parties. This is a principle that has been followed consistently - from the time the Trademark Review Commission released its report, through all the legislative process leading to passage of the TLRA,⁵ during the painstaking development of the Trademark Rules in 1989, the instructions contained in the first intent-to-use examination guidelines⁶ later reflected in the Trademark Manual of Examining Procedure,⁷ as well as in specific cases decided over the past fifteen years by the Commissioner⁸ and by the Trademark Trial and Appeal Board.⁹

⁵ Senate Report No. 515, 100th Congress, 1st Session, Senate Judiciary Committee Report on S.1883, September 15, 1988, p. 24, reprinted in 1988 U.S. Code Cong. & Admin. News 5577, 5586. "As the mark proceeds to registration, the goods identified in the application may be narrowed, but they may not be broadened."

⁶ Exam Guide 3-89, "Trademark Official Gazette," November 21, 1989, 1108 TMOG 30.

⁷ TMEP §1402.07(c) makes it clear that "[a]n applicant may amend an unambiguous identification of *services* that indicates a specific type of service to specify definite and acceptable identifications of *services within the scope of the existing terminology*."

⁸ See In re M.V. Et Associes, 21 USPQ2d 1628 (Comm'r Pats. 1991). This case involved the mere addition of new items of clothing beyond an express amendment during prosecution.

⁹ In re Swen Sonic Corp., 21 USPQ2d 1794 (TTAB 1991).

By contrast, to permit an applicant wide latitude in changing the recitation of services during the course of prosecuting an application could well jeopardize the rights of a third party who might rely to its detriment upon the scope and contents of a recitation of services in a pending trademark application. Instead of bringing greater certainty to the process of clearing marks, a looser interpretation of these provisions would have the opposite and unintended effect of creating greater uncertainty. The amended statute, changed rules and details of Office practice have been calibrated over the past fifteen years to ensure a balanced, reasonable and pragmatic system for applicants, while taking into consideration the important interests of third parties operating in the marketplace.

Accordingly, applicant's proposed amendment to the recitation of services is unacceptable, and the requirement for further amendments to the recitation of services as required by the Trademark Examining Attorney is affirmed.¹⁰

¹⁰ With its reply brief, applicant has attached eight prior federal service mark registrations owned by applicant for entertainment services. This material is clearly untimely, see Trademark Rule 2.142(d), and has not been considered. However, even if we had considered it, we find it irrelevant to the issues before us. The first issue in this proceeding is whether applicant's proposed amendment would place the recitation beyond the scope of the earlier recited services. The issue has not been the nature of applicant's business, but rather the propriety of accepting a specific amendment to the recitation of services

Need for substitute specimens

In sophisticated service economies like our own, service marks are used in a myriad of ways. Not surprisingly then, the types of specimens that demonstrate the use of service marks are legion. Consistent with the ever-changing nuances of the marketplace, U.S. trademark law and administrative practice have developed in sync with the changes in services since the passage of the Trademark Act of 1946. Hence, irrespective of the recited services, during the prosecution of an application before the United States Patent and Trademark Office, the trademark applicant must currently furnish a specimen (or facsimile) demonstrating use of the mark in connection with each class of services for which registration is sought. See Trademark Rule 2.56, 37 C.F.R. §2.56.

Moreover, the statutory definition of a "service mark" leads inexorably to a requirement that there be a direct association between the service mark and the services. The manner of use of the alleged service mark on the specimens must be such that potential purchasers readily perceive the subject matter as identifying and distinguishing the applicant's services and indicating their source, even if

under the exact circumstances that transpired during the prosecution of the instant application.

that source is unknown. Section 45 of the Trademark Act, 15 U.S.C. §1127; TMEP § 1301.04.

Whether a mark has indeed been used for a particular service is a question of fact to be determined primarily on the basis of the specimen of record. See In re Advertising & Marketing Development, Inc., 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) [the Court of Appeals for the Federal Circuit reaffirmed the holding of the CCPA (In re Universal Oil Prods. Co., 476 F.2d 653, 177 USPQ 456 (CCPA 1973)) in which case applicant had failed to show a "direct association" between the mark and the services named in the application]; In re Duratech Industries Inc., 13 USPQ2d 2052 (TTAB 1989) [a bumper sticker featuring the design sought to be registered is unacceptable as a specimen because members of the public would not perceive the design on the bumper sticker as a mark identifying the services]; and In re Adair, 45 USPQ2d 1211 (TTAB 1997) [tags bearing mark failed to show use of that mark to identify services recited in the application].

Accordingly, to determine whether applicant's alleged service mark has been used in connection with the recited services, the Trademark Examining Attorney looks carefully at the specimen of record, giving due consideration to

applicant's explanations as to how the specimen is actually being used.

Applicant describes the specimens as "a display of the mark as foreground and in the color as it appears on the broadcasted material." In form, the service mark specimen is in the nature of a peel-off decal or square bumper sticker. Whether nominated as a decal, label, bumper sticker or "display," there is nothing in the record showing the term \$PEND IT FA\$T being used as a service mark for entertainment services in International Class 41. Stated differently, nowhere is it clear how the mark sought to be registered functions as a source indicator in connection with the services rendered by applicant.

There is no language at all in the specimens that makes either a direct or an indirect association between the term \$PEND IT FA\$T and the production of entertainment programs such as motion pictures. While the exact nature of the services does not need to be specified in the specimens, there must be something that creates in the mind of the purchaser an association between the mark and the service activity. See In re Johnson Controls, Inc., 33 USPQ2d 1318 (TTAB 1994), citing to Intermed Communications Inc. v. Chaney, 191 USPQ 501 (TTAB 1977) and In re Metriplex, Inc. 23 USPQ2d 1315 (TTAB 1992).

Even if, as applicant argues, some potential consumers may well understand this phrase to mean "life is short and to be enjoyed and with respect to accumulated wealth - SPEND IT FAST" (applicant's response of June 25, 2001), applicant has failed to demonstrate a nexus between the expression \$PEND IT FA\$T and the recited services.

Consequently, in the absence of any association or nexus between the alleged service mark and the services recited in the instant application, we affirm the refusal of the Trademark Examining Attorney to approve the registration of this mark for entertainment services.

Decision: We affirm both requirements made by the Trademark Examining Attorney, namely (i) the refusal to accept the proposed amended recitation of services, and (ii) the refusal to register on the ground that the specimens of record are not acceptable evidence of actual service mark usage of the term \$PEND IT FA\$T, and applicant has failed to submit acceptable substitute specimens as required by the Trademark Examining Attorney.